UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,802	10/11/2005	Bernhard Gleich	DE030111US1	4533

24737 7590 12/16/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
CHEN, VICTORIA W	

ART UNIT	PAPER NUMBER
3739	

MAIL DATE	DELIVERY MODE
12/16/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/552,802	GLEICH ET AL.	
	Examiner	Art Unit	
	VICTORIA W. CHEN	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/31/09*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10/11/05* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the magnetic field that is positionally and temporally variable" in ll. 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8-11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraus, Jr. et al. (US Pat No 6470220 B1) in view of McKinnon (US 6462544 B1).

Regarding claims 1, 3-6 and 13, Kraus, Jr. teaches an apparatus and method for heating magnetic particles in a target region by generating a magnetic field having a first low magnetic strength region and a second high magnetic strength region which is formed and changing the position in space of the sub-regions to change the magnetization of the particles for so long and

with such a frequency that the target region is heated, along with means for the acquisition and analysis of signals on the spatial distribution of the particles [col. 13, ll. 9-62 and see claim 1]. However, Kraus fails to specifically teach the region of action situated outside the space surrounding the arrangement having means for generating the magnetic field. McKinnon teaches a magnetic field arrangement [141, Fig. 1] which generates a magnetic field in a region of action which is located outside the space surrounding the arrangement [Fig. 1, patient is located above the arrangement] in order to improve comfort and prevent a claustrophobic effect experienced by the patient [col. 1, ll. 32-50]. Therefore, it would have been obvious to one of ordinary skill in the art to modify the placement of the region of action as taught by Kraus by locating it outside the space surrounding the arrangement having means for generating the magnetic field as taught by McKinnon in order to improve comfort and prevent a claustrophobic effect experienced by the patient.

Regarding claim 2, Kraus, Jr. teaches using a positionally and temporally variable magnetic field to change the position in space of the two sub-zones in the region of action [col. 13, ll. 9-14].

Regarding claims 8 and 9, Kraus, Jr. teaches the arrangement is capable of using two coils arranged concentrically within the other through which current flows in opposite directions of circulation [col. 16, ll. 40-56] or a mix of coils and magnets [col. 14, ll. 41-44].

Regarding claims 10 and 11, McKinnon teaches a housing enclosing the arrangement [141] outside which housing the region of action is situated in front of a side of the housing [Fig. 2] and a table [60].

Regarding claim 14, Kraus, Jr. teaches that the signals induced in the region of action are received by a coil arrangement [col. 13, ll. 16-18].

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 3, 4, 5, 6, 7, 12, 13 and 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-7 of U.S. Patent No. 7351194. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a method and arrangement for influencing magnetic particles in a region of action by generating a magnetic field having first and second sub-zones that are changed in position in space such that the magnetization of the particles changes locally, acquiring and analyzing signals to obtain information on the spatial distribution of the magnetic particles in the region of action, heating the region of action, and shifting the position of the sub-zones via a temporally variable magnetic field superimposed on a gradient magnetic field.

Allowable Subject Matter

Claims 7 and 12 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims and with a proper terminal disclaimer.

Response to Arguments

Applicant's arguments filed 8/31/09 have been fully considered but they are not persuasive. Regarding applicant's argument that Kraus fails to teach generating a magnetic field with first and second sub-zones, having a low and a higher magnetic field strength, respectively, Kraus teaches using four pairs of magnetic coils arranged in a circle, where opposing coils are activated together and adjacent coil pairs are activated in a sinusoidal pattern such there is a higher strength field between a pair of coils and a lower strength field between the adjacent pair of coils in a given instant. The sinusoidal pattern of the current supplied to the coil pairs causes the changing of positions of the field sub-zones, thus effecting the rotation of the magnetic particles [col. 13, ll. 14-32].

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applicant's invention not requiring mechanical movements) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/
Examiner, Art Unit 3739

/Roy D. Gibson/
Primary Examiner, Art Unit 3739